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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,912	03/15/2001	Atsushi Hanai	R2179.0000/P000	2913

24998 7590 07/13/2005

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP  
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EXAMINER
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THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/805,912

Applicant(s)

HANAI ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-19, 21, 23 and 41-48 is/are pending in the application.
- 4a) Of the above claim(s) 43-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-19, 21, 23, 41 and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3-8-05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicants' "Amendment in Response to Non-Final Office Action" filed on April 18, 2005 has been considered with the following effect.

Applicants' response by virtue of amendment to claim 21 has overcome the Examiner's rejection of such claim under 35 USC 101.

Applicants' response by virtue of amendment to claim 23 has not overcome the Examiner's rejection of such claim under 35 USC 101. The Applicants has not overcome the Examiner's rejection because it fails to recite computer executable instructions. The claims are directed to computer program product. The claims fail to recite a positive functional interrelationship between the medium and the activities recited. Please refer to MPEP 2106. However, the Applicants have overcome the rejection based on the recitation of "outputting a signal".

Claims 13, 21, and 23 have been amended. New claims 41-48 have been added. Claims 1-12, 20, 22 and 24-40 have been canceled. Claims 13-19, 21, 23, and 41-48 remain pending in this application.

### ***Information Disclosure Statement***

The Foreign Patent Document in the information disclosure statement (IDS) submitted on March 8, 2005 is being considered by the examiner. However, the non-foreign patent literature documents are not being considered because copies of the English-language translation were not provided.

### ***Election/Restrictions***

***Election by Original Presentation***

Newly submitted claims 43-48 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims have separate utility such as providing an online shopping site and registering client information if the accessing user is unregistered user.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 43-48 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 101***

**35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that

promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is

presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In Toma, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently

acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, Claim 23 has no connection to the technological arts because it fails to recite computer executable instructions. The claims are directed to computer program product. The claims fail to recite a positive functional interrelationship between the medium and the activities recited. Please refer to MPEP 2106. For example, the claim can be amended to recite "A computer program stored in a computer readable medium having computer executable instructions comprising:.....".

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 13-19, 21, 23 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6, 266,649 to Linden et al. in view of U.S. Patent No. 6,519,571 to Guheen et al. and in further view of U.S. Patent No. 6,438,579 to Hosken.**

Regarding claims 13-14, and 41-42, Linden discloses an item recommending system, method and program (personalized recommendation of items, col. 2, lines 34-35) comprising: a client database (user profile 38) which stores possessed item

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information representing items possessed by each of the clients (purchase history); a related information storing memory which contains relationship information concerning purchase items and related items (similar item table 40); a possessed item extractor which, in response to the client information, extracts from the client database the item the client possess (the items of known interest are selected from one or more of the following groups: (a) items in the user's purchase history, (b) items in the user's shopping cart, (c) items rated by the user, and (d) items in the recent shopping cart content, col. 10, lines 47-55); a related item extractor (the items of known interest are identified based on information stored in the user's profile, col. 10, lines 37-40); and a recommendation section (recommendation service component 44, Figure 1).

However, Linden does not disclose the client information representing attribution of clients including personal users and corporation users and a client specifier.

Furthermore, Linden does not disclose the client database stores discount information **(claim 14)**. Moreover, Linden does not disclose the client database includes persona ID data including personal passwords persons in charge of each corporation client with respect to corporation ID; the client specifier specifies a corporation user client by identifying both the corporation ID and personal ID based on the client information; and discount information corresponding to a discount rate of a sales price with respect to each corporation user client **(claims 41-42)**. Linden discloses a user profile database which stores account-specific information about user of the site (col. 7, lines 20-22). Guheen, on the other hand, teaches the client information representing attribution of clients including personal users and corporation users and a client specifier (col. 210,



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lines 32 – col. 211, line 8; col. 211, lines 10-13; col. 271, lines 10-16). Furthermore, Guheen teaches the discount information (**claim 14**) (col. 190, lines 50-55; col. 191, lines 21-27; col. 270, lines 1-5). Moreover, Linden does not disclose the client database includes personal ID data including personal passwords persons in charge of each corporation client with respect to corporation ID; the client specifier specifies a corporation user client by identifying both the corporation ID and personal ID based on the client information; and discount information corresponding to a discount rate of a sales price with respect to each corporation user client (**claims 41-42**) (col. 148, lines 12-20; col. 270, lines 1-5; col. 271, lines 10-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system, method and program of Linden, to include the client information representing attribution of clients including personal users and corporation users and a client specifier, as taught by Guheen, in order to maintain user information and preferences (Guheen, col. 210, line 32) so as to provide presentations that is customized based on the user profile (Guheen, col. 210, lines 60-61).

However, Linden does not disclose a client database which stores the recommendable item information representing items to be recommended to each of the client. Linden discloses a user profile database which stores account-specific information about user of the site (col. 7, lines 20-22). Furthermore, Linden discloses the data stored for each user may include one or more of the following types of information than can be used to generate recommendations (col. 7, lines 25-27). Hosken, on the other hand, teaches a client database which stores the recommendable

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item information representing items to be recommended to each of the client (col. 7, lines 37-42).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system, method and program of Linden, to include a client database which stores the recommendable item information, as taught by Hosken, in order to store the history of recommendation sets presented to a user in connection with the user profile (Hosken, col. 7, lines 37-39).

Regarding claims 15-19, Linden discloses a receiver which received identification information (user ID) (Figure 3); a specifier which specifies the client based on the received identification information (Figure 3); means for inputting item purchase information (users can add and remove items to/from a personal shopping cart; col. 4, lines 64-65; col. 7, lines 49-52); means for adding an item that the client possesses to the client database (processing modules for accepting and processing orders, and for updating the purchase histories of the users (col. 7, lines 45-48); wherein the related information storing memory stores a plurality of purchase items, an option item to be used as an option in each purchase item and/or a consumable item to be consumed in the purchase items, and the related information storing memory recommends the option item to the purchase item that the client possesses and/or the consumable item (col. 7, lines 20-33); a sales history (purchase histories for all customer); a memory which stores information on items show probability of simultaneous purchase is more than a reference value to the related information storing memory based on the sales history stored in the history storing memory (col. 2, line 61 – col. 3, line 6); and the sales history

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storing memory stores both the history of items sold together by a store and/or a salesperson and the history of items sold together via a network (col. 12, lines 5-9).

Regarding claims 21 and 23, Linden, Guheen, and Hosken discloses an item recommending method and program as set forth above in detail for claim 13.

### ***Response to Arguments***

Applicant's arguments with respect to claims 13-19, 21, and 23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

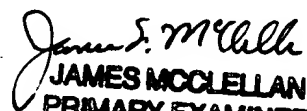
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
July 7, 2005

  
JAMES MCCLELLAN  
PRIMARY EXAMINER  
Au 3627